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Keith D. Nowak Carter Ledyard & Milburn LLP 2 Wall Street New York, NY 10005				
EXAMINER				
LASTRA, DANIEL				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/766,006

**Applicant(s)**

CORRIERE, RICHARD

**Examiner**

DANIEL LASTRA

**Art Unit**

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-20 have been examined. Application 10/766,006 (COMMUNICATION SYSTEM FOR BUSINESS MARKETING INCLUDING A POINT SYSTEM TO MOTIVATE USERS) has a filing date 01/29/2004.

***Response to Amendment***

2. In response to Non Final Rejection filed 01/10/2008, the Applicant filed an Amendment on 07/10/2008, which amended claims 1 and 17-20.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. With respect to claims 1-18, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory

class of invention (such as a particular apparatus). With respect to claims 19 and 20 said claims are defined as system claims however, are claiming functional descriptive material (i.e. software), as "communication medium" is defined in Applicant's specification as software.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims are indefinite as they are not system claims. Claims 17 and 19 are indefinite because it is not clear how the sponsor can be a school, an employer, a recruiter and a doctor.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 6-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyd (US 2004/0193489).

Claim 1, Boyd teaches:

A method for a sponsor to motivate a user based on a rewards program, the sponsor and user communicating over a communications medium, the method comprising:

awarding points to the user in response to a behavior by the user, *the behavior being learning about the sponsor*, the behavior excluding a purchase of goods or services by the user *wherein the sponsor comprises a merchant* (see paragraph 135 "earning points by registering"; see paragraph 137 "earning points by viewing advertisements"); and

redeeming the points of the user in exchange for rewards, the points being exclusively redeemable through the sponsor (see paragraph 166 "points can only be redeemed at Yahoo's website or other merchants with some contractual relationship with Yahoo").

Claim 2, Boyd teaches:

wherein the communications medium includes the Internet (see paragraph 27).

Claim 3, Boyd teaches:

wherein the communications medium includes a private network (see paragraph 94).

Claim 4, Boyd teaches:

wherein the communications medium includes a telephone system (see paragraph 24).

Claim 6, Boyd teaches:

wherein the behavior comprises supplying user information (see paragraph 135 "earning points by registering").

Claim 7, Boyd teaches:

wherein the behavior comprises the user's clicking on a web page provided by the sponsor (see paragraph 137).

Claim 8, Boyd teaches:

awarding points as a factor of the frequency of consumer communications with the sponsor (see paragraph 156).

Claim 9, Boyd teaches:

maintaining information based on communications with multiple users (see paragraph 166).

Claim 10, Boyd teaches:

analyzing the information (see paragraph 182).

Claim 11, Boyd teaches:

maintaining information based on multiple communications with one user (see paragraph 179).

Claim 12, Boyd teaches:

analyzing the information (see paragraph 179).

Claim 13, Boyd teaches:

sending an email to the user based on information obtained from the user (see paragraph 93)

Claim 14, Boyd teaches:

redeeming points for goods or services (see paragraph 167).

Claim 15, Boyd teaches:

redeeming points for entry in a sweepstakes (see paragraphs 143, 168 "gift certificates") .

Claim 16, Boyd teaches:

wherein the rewards comprise goods or services supplied, in part or in whole, in barter (see paragraph 403).

Claim 17, Boyd teaches:

wherein the sponsor *further comprises a an employer, a recruiter* (see paragraph 95 "award points to its employees"; "signing for a trial membership"). Boyd does not teach that said sponsor is a *school, an a doctor*. However, Official Notice is taken that it is old and well known in the promotion art for schools and doctors to award incentives to his clients. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that doctors and schools would participate in the Boyd loyalty system in order to provide an incentive for clients to interact with said doctors and schools.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (US 2004/0193489).

Claim 5, Boyd fails to teach wherein the communications medium includes wireless communications. However, Official Notice is taken that it is old and well known in the communication art for a user to connect to the Internet via a wireless connection. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user of the Boyd's system would connect to the Internet via a wireless connection as it is old and well known to do so.

Claim 19, Boyd teaches:

A system for implementing a rewards-based program, the system comprising:

a communications medium (see figure 1); at least one user computer used by a user (see figure 1, item 103); and

at least one rewards program server (see figure 1 item 110), the at least one rewards program server programmed to award points to the user in response to a behavior by the user (see paragraph 135), *the behavior being learning about a sponsor*, the behavior excluding a purchase of goods or services by the user (see paragraph 135 "earning awards for registering"; paragraph 137 "earning awards for viewing advertisements"), the rewards program server further programmed to redeem the points of the user in exchange for rewards, the points being exclusively redeemable through the sponsor, *wherein the sponsor comprises a merchant, an employer, and a recruiter*



(see paragraph 166 “points can only be redeemed at Yahoo’s website or other merchants with some contractual relationship with Yahoo”; (see paragraph 95 “award points to its employees”; “signing for a trial membership”). Boyd does not teach that said sponsor is a *school, an a doctor*. However, Official Notice is taken that it is old and well known in the promotion art for schools and doctors to award incentives to his clients. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that doctors and schools would participate in the Boyd loyalty system in order to provide an incentive for clients to interact with said doctors and schools.

Claim 20, Boyd teaches:

wherein the at least one rewards program server hosts a plurality of rewards-based programs for a plurality of sponsors (see paragraph 133).

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (US 2004/0193489) in view of Goldhaber (US 5,855,008).

Claim 18, Boyd fails to teach wherein the sponsor engages the services of a program manager as an agent of the *sponsor*. However, Goldhaber teaches a system that compensates consumers for paying attention to advertisements and where said system employs the service of an agent of a merchant in order to find clients (see Goldhaber col 15, lines 12-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Boyd’s merchants would employ the service of an agent, as taught by Goldhaber in order that

said agent works in behalf of said merchants, searching out interested viewers and bringing it to their attention.

***Response to Arguments***

8. Applicant's arguments filed 07/10/2008 have been fully considered but they are not persuasive. The Applicant argues that Boyd does not teach "awarding points for the behavior of learning about the sponsor". The Applicant further argues that Boyd does not teach Applicant's claimed invention because Boyd intertwines incentive point with an auction system and therefore, users are not earning points for learning about a sponsor. The Examiner answers that Boyd teaches awarding points to users for viewing advertisements, visiting sponsor's websites and submitting products reviews (see paragraphs 139-160). Therefore, contrary to Applicant's argument, Boyd teaches Applicant's claimed invention.

The Applicant argues that in Boyd, consumers are not redeeming points exclusively from the sponsor. The Examiner answers that Boyd teaches that Yahoo points are redeemable at any Yahoo authorized website and other merchant with contractual relationship with Yahoo (See paragraph 166). Therefore, contrary to Applicant's argument, Boyd teaches Applicant's claimed invention.

The Applicant argues that Goldhaber does not teach "the sponsor using a program manager as an agent of the sponsor" because according to the Applicant, in Goldhaber, the agent is not a motivator. The Examiner answers that the Applicant is arguing about limitation not stated in the claims.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
November 5, 2008